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10/598,429

10/16/2006

Jean-Luc Carrez

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LEVINE & MANDELBAUM
222 Bloomingdale Road
Suite 203
WHITE PLAINS, NY 10605

EXAMINER

TANNER, JOCELYN C

ART UNIT

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3731

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/598,429 | Applicant(s) CARREZ ET AL. | |
| | Examiner JOCELIN C. TANNER | Art Unit 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 1-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the Amendment filed 11 January 2010. Claims 1-9 are currently pending. The Examiner acknowledges the amendments to claims 1 and 5.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 January 2010 has been entered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "trap" in line 8 of claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1-9 are objected to because of the following informalities: The use of reference numerals in the claims is misleading and should not be used as a substitute for clear recitation of structure. The Examiner suggests deletion of the numerals for clarity. Appropriate correction is required.
4. Claim 1 is objected to because of the following informalities: In line 5, "this chamber" should be "a chamber". Appropriate correction is required.
5. Claim 7 is objected to because of the following informalities: In line 3, "clickon" should be "click on". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Regarding claim 1, the recitation in line 5, "this chamber forms a chamber" is vague since it is unclear if the first mentioned chamber is referring to the anti-prick cage as stated in line 13 of claim 1 or another chamber. For the purposes of the rejection, the limitation will be treated as the anti-prick cage having a chamber formed therein.

9. Regarding claim 1, the recitation in line 30, "this end" is vague since it is unclear if it is referring to the opposite end or the end of the needle. For the purposes of the rejection, the limitation will be treated as referring to the needle.

10. Claim 5 recites the limitation "said contact end" in line 5. There is insufficient antecedent basis for this limitation in the claim. It is unclear if the "contact end" is also the "opposite end" of the retention device.

11. Claim 5 recites the limitation "the lever" in line 8. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 9 recites the limitation "the lever" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogert (US Patent No. 5,853,393) in view of Purdy et al. (US Patent No. 5,215,528).

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3. Regarding claims **1 and 6**, Bogert discloses an arrangement for the insertion into a vein of a cannula including a proximal base (28) of a short tubular catheter (column 6, lines 1-5), a needle (22) having a skin-puncture end (Fig. 2), an anti-prick cage which extends the base in the proximal direction, the anti-prick cage forming a chamber through which the needle slides from a proximal entrance to a distal exit of the chamber, the cage and base having retention resources that combine to perform temporary retention of the cage on the catheter base before the puncture end of the needle is trapped in the chamber of the cage, the retention resources including an external rim (50) formed on the base and an external dog (46) held by the rim, the dog is formed at one end of a retention device and is mounted to have the capability to tilt in the cage on its own due to its plastic material(column 6, lines 8-26), unbiased by any other force-producing component, from a position permitting withdrawal of the needle into the cage to a position blocking the exit of the needle from the cage (Figs. 1, 2), the dog is capable of tilting around a pivoting axis transverse to the sliding direction of the needle, the retention device having an opposite end (60, Fig. 3) in lateral contact with the needle when the latter transverses the cage, the only friction between the needle and the opposite end of the device being due to the weight of the end of the device, the device being capable of tilting around the axis when it is not longer in contact with the needle such that the dog lifts and releases itself from the rim to position itself in front of the puncture end to prevent the end from exiting the chamber (column 6, lines 8-20, Fig. 2). However, Bogert fails to disclose a trap to hold the puncture end of the needle in the chamber when the needle is withdrawn from the catheter base.

Purdy et al. teaches a device having a needle tip shield wherein the needle (14) includes an enlarged diameter portion (14c) to prevent the needle from being fully withdrawn from the needle tip cover and being exposed (column 4, lines 28-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the device of the combination of Bogert and Smith with retention resources, as taught by Purdy et al., to prevent the needle from being fully withdrawn from the cage and to provide a seal between the catheter and the needle shaft.

4. Regarding claim 2, the combination of Bogert and Purdy et al. discloses the claimed invention except expressly disclosing that the weight of the part of the device located between the pivoting axis and the retention end is less than the weight of the part of the device located between the axis and the contact end. It would have been an obvious matter of design choice to construct the retention device having the weight of the part of the device located between the pivoting axis and the retention end is less than the weight of the part of the device located between the axis and the contact end, since applicant has not disclosed that having the weight of the part of the device located between the pivoting axis and the retention end is less than the weight of the part of the device located between the axis and the contact end solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with having the weight distributed in a form required to sufficiently create a pivoting device.

5. Claim 3, 4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogert (US Patent No. 5,853,393) in view of Purdy et al. (US

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Patent No. 5,215,528), as applied to claims 1 and 2 above, and further in view of Gaba (US Patent No. 5,697,907).

6. Regarding claims **3 and 7**, the combination of Bogert and Purdy et al. discloses all of the limitations previously discussed except for the pivoting axis including lateral nipples formed on the retention device and accommodated in a cradle formed on the cage

Gaba teaches a device to prevent exposure of a needle point including a pivoting retainer (318) wherein lateral nipples (310) formed thereon and accommodated within a cradle created by cut-outs in two opposite walls of housing (column 5, lines 3-5, Figs. 10-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a cradle to the housing of the needle and lateral nipples to the end of the other arm of the retention device of the combination of Bogert and Purdy et al., as taught by Gaba, since it is well known to obtain pivoting function by providing a cradle and nipples and to produce secure and stronger pivoting means.

7. Regarding claims **4 and 8**, Gaba teaches a cradle that is capable of being placed within the housing by click-on action.

8. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogert (US Patent No. 5,853,393) in view of Purdy et al. (US Patent No. 5,215,528), as applied to claims 1 and 2 above, and further in view of Eck (US Patent No. 5,498,244).

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9. Regarding claims **5 and 9**, the combination of Bogert and Purdy et al. discloses all of the limitations previously discussed except for the retention device having an integral flexible tongue which is movable from a disengaged position distal from a wall of the cage to a position wherein the tongue is trapped under the wall of the cage.

Eck teaches a safety guard device wherein the means for securing the guard include a biasing arm (12) or intrusion tab (13) having a locking protrusion (19) of any shape or dimension that suffices to hold the intrusion tab (13) in a desired position, the locking protrusion used to secure engagement to an adjacent structure wherein the locking protrusion is securely retained by a locking channel (20) or trapped under the wall of an adjacent structure (21) (column 9, lines 31-65, Figs. 4-6, 15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a channel and a tongue that is capable of being engaged and disengaged from under a channel within the wall of the cage of the retention device of the combination of Bogert and Purdy et al., as taught by Eck, to provide further latching means for securing a needle within an anti-prick cage (column 9, lines 31-32).

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOCELIN C. TANNER whose telephone number is

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(571)270-5202. The examiner can normally be reached on Monday through Thursday between 9am and 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jocelin C. Tanner/
1/29/2010
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
1/31/10